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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,522	12/08/2003	Ashok R. Thakrar	D-4104	2978

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,522

Applicant(s)

THAKRAR, ASHOK R.

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 30-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29 is/are rejected.
- 7) ☒ Claim(s) 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/12/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election without traverse of Group I, claims 1-29 in the Election of May 18, 2004 is acknowledged.

Information Disclosure Statement

The information disclosure statement filed April 12, 2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 for the following reason. Specifically, applicant has cited U.S. application number 10/306,716 but has not complied with the provisions of 37 CFR 1.98. This provision of the CFR requires that for any cited US patent application, applicant is required to provide copies of the specification (including claims) and the drawings of the cited application, or that portion of the application which caused it to be cited, including any claims directed to that portion. Therefore, the cited application has been crossed out and has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

Claim Rejections - 35 USC § 112

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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With reference to claim 6, "the particles" lacks an antecedent basis and it is not clear if the intended meaning is that the image component comprises particles, the multilayered interference film comprises particles or if the dependency of the claim is incorrect rendering the claim vague and indefinite. For purposes of examination it is assumed that claim 6 meant to depend from claim 4 (instead of claim 3).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 9-10, 12-15, 17-27 and 29 are rejected under 35

U.S.C. 102(b) as being anticipated by Cohen patent number 4,889,421.

Cohen reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract); a lens body having an optical region, an anterior surface and a posterior surface (abstract, Figures such as Figure 10); an image component disposed on or within the lens body (column 4, line 51 to column 5, line 35 re the grid pattern as the image component); the image

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component being effective in producing a color shifting appearance (as this term is defined on pages 2-3 of applicant's specification re Cohen, column 4, lines 4-10, column 7, lines 1-18, column 9, line 65 to column 10, line 23, column 11, line 46). Cohen further discloses a light diffractive component (column 4, line 54); the image component comprising a multilayered interference film (column 4, line 54, column 13, line 10, and Figures 2-6). All objects inherently comprise particles and therefore the multilayered interference film will inherently comprise particles and will inherently be distributed through a medium and of a size less than about hundred micrometers as well. Cohen further discloses the medium as a polymeric material (column 12, line 28 to column 13, line 28); that the film can be substantially absent of any intrinsic color (column 4, line 30 to column 5, line 8); each film layer effective in exhibiting a different light interference property (Figure 2, column 5, line 43); the image component as a layer on or integrated into the lens body (Figures 8-11, column 9, lines 46-56); the image component expelled from an inkjet printer (column 12, line 16). The image component of Cohen will inherently produce a rainbow colored spectral appearance, this being reasonably based upon Cohen disclosing the component producing a "shimmering or glittery illusory metal image with movement and depth (column 4, line 63). Cohen further discloses the image component structured to interfere with incident light (column 4, line 51 to column 5, line 35); to cause a color of the image to change when the lens is viewed from different angles (column 4, line 51 to column 5, line 35, column 7, lines 1-18, column 9, line 65); the image component provided as an annulus on a surface of the lens or between surfaces of the lens (Figures 8-10);

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the image component to create a three dimensional appearance of at least a portion of an eye (column 5, line 9); and the image component further comprising at least one non-diffractive colorant (column 12, line 27 to column 13, line 20).

Claims 1-2, 12, 14, 16-18, 20, 23, 25-27, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Quinn et al publication number 2003/0054109.

Quinn et al reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract); a lens body having an optical region, an anterior surface and a posterior surface (paragraphs 0040-0041, 0049-0050, 0095); an image component disposed on or within the lens body (paragraph 0038); the image component being effective in producing a color shifting appearance (paragraph 0038). Specifically, the particles that are not colored but that give the appearance of color through diffraction or scattering of light will inherently cause the object to appear to change color upon variation of the angle of incident light and/or as the viewing angle of the observer is shifted this being reasonably based upon the similarity in structure to that of the claimed invention. Quinn et al further discloses a light diffractive component (paragraph 0038 re particles that provide diffraction or scattering of light); the image component provided as a layer on the anterior surface (paragraph 0055, 103); the image component expelled from an inkjet printer (paragraph 0027); the lens further comprising a phosphorescent pigment (paragraphs 0035 and 0038); the image component provided as an annulus on a surface of the lens (paragraphs

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0095-0096, 105); the image component further comprising at least one non-diffractive colorant (paragraph 0037, 0096, 107-111).

Claims 1-13, 15, 17-23, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Li et al patent number 6,164,777.

Li et al reads on these claims by disclosing the limitations therein including the following: a contact lens (abstract); a lens body having an optical region, an anterior surface and a posterior surface (column 7, line 37 to column 8, line 3); an image component disposed on or within the lens body (abstract, column 3, line 9, column 4, lines 8-57); the image component being effective in producing a color shifting appearance (abstract, column 3, line 9, column 4, lines 8-57).

Specifically, the multilayer interference films will inherently cause the object to appear to change color upon variation of the angle of incident light and/or as the viewing angle of the observer is shifted this being reasonably based upon the color being produced by light interference and light reflection as well as upon the similarity in structure (i.e. through the use of multilayered interference films) to that of the claimed invention. Li et al further discloses a light diffractive component and the image component comprising a multilayered interference film (column 4 lines 8-57). All objects inherently comprise particles and therefore the multilayered interference film will inherently comprise particles and distributed through a medium and of a size less than about hundred micrometers as well. Li et al further discloses the medium as a polymeric material (column 6, lines 13 to column 7, line 41); the polymeric material as set forth in claim 8 (column 6, line 21 to column 7, line 5); different films imparting different interference properties

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(column 7, lines 6-36); particles of interference film and of reflective film (column 4 lines 8-57, column 7, lines 6-65); the image component as a layer on or integrated into the lens body (column 7, lines 37-55). The image component of Li et al will inherently impart a rainbow color, this being reasonably based upon Li et al using a multilayer interference film to provide the color similar to that of the claimed invention. Li et al further discloses the image component provided as an annulus on a surface of the lens or between surfaces of the lens (column 7, line 38 to column 8, line 3).

Prior Art Citations

Benz et al publication number 2002/0058723 is being cited herein to show a contact lens material that would have made obvious the polymeric material of claim 8, however such a rejection would have been repetitive (paragraphs 9-13). Neefe patent number 4,701,038, Neefe patent number 4,639,105, Quinn et al patent number 6,196,683 and WO/31585 are being cited herein to show other contact lens references that would have read on a number of the above rejected claims, however, such rejections would have been repetitive.

Allowable Subject Matter

Claim 28 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of

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limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claim 28, none of the prior art either alone or in combination, disclose or teach of the claimed contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed ink pixels as bleached.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

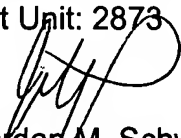
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Jordan M. Schwartz', is written over the printed name.

Jordan M. Schwartz

Primary Examiner

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July 16, 2004